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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,270	01/19/2001	Takamichi Sekido	01028/LH	1334
1933	7590	11/03/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 767 THIRD AVENUE 25TH FLOOR NEW YORK, NY 10017-2023			NGUYEN, CHAU T	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,270

Applicant(s)

SEKIDO ET AL.

Examiner

Chau Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2176

DETAILED ACTION

1. Claims 1-31 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitation "the document file" in 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

Art Unit: 2176

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 8-10, 12-17, 25-26, 28-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Takeda et al. (Takeda), US Patent No. 6, 549,302.

7. As to claims 8 and 25, Takeda discloses a document handling apparatus for editing document file data comprising:

document file importing means, wherein said importing means creates new document file having a predetermined format on the basis of an import of an original document file (col. 8, line 14 – col. 9, line 43); and

document file relating means for relating said created new document file with said original document file (col. 8, line 14 – col. 9, line 43).

8. As to claim 9, Takeda discloses document file operating means for creating a duplicated file of said new document file and for dividing the duplicated file for each page (col. 14, line 18 – col. 15, line 53).

9. As to claims 10, 15 and 26, Takeda discloses wherein said predetermined format is a wide-used format for document (col. 8, lines 18-28).

Art Unit: 2176

10. As to claims 12 and 16, Takeda discloses wherein said document file relating means relates said created new document file with said original document file by storing both files in a predetermined directory (col. 9 lines 14-29).

11. As to claims 13, 17 and 31, Takada discloses wherein each document file is corresponding to file data stored in a memory, and at least one of said document file importing means and said document file relating means operates each document file on the basis of the file data in the memory (col. 9 lines 14-29 and Figs. 6-8).

12. As to claims 14 and 28-29, Takeda discloses a document handling apparatus for editing document file data comprising:

document file importing means for importing first document file (col. 8, line 14 – col. 9, line 43);

document file creating means for creating second document file by converting first document file in a predetermined format file (col. 8, line 14 – col. 9, line 43);

editing means for executing a page division process and/or a page editing process for document files, wherein said editing means creates third document files duplicated from said second document file, and execute the page division process and /or the page editing process on the basis of said third document file (col. 14, line 18 – col. 15, line 53); and

Art Unit: 2176

document relational means for relating said first document file with said second document file and for relating said second document file with third document file (col. 8, line 14 – col. 9, line 43).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 11 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda as applied to claims 8-10 and 12 above, and further in view of Stumbo et al. (Stumbo), US Patent No. 6,084,688.

15. As to claims 11 and 27, Takeda discloses converting a scan document into an image document (col. 8, line 14 – col. 9, line 43). However, Takeda does not explicitly disclose wherein said predetermined format is PDF format. Stumbo discloses converting an image into a portable document format or PDF (Stumbo, col. 1, lines 44-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Stumbo and

Art Unit: 2176

Takeda to include converting a document file into a PDF since the advantage of the portable document format is that it is page-independent and multi-page document converted into a PDF can be divided into subsets of data , and each subset of data corresponding to one of the multiple page images in the job or document. By doing this way, a number of individual page images in a multi-page document can be decomposed in parallel, thus reducing the amount of time required to decompose an entire multi-page document.

16. Claims 1-7 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conrad et al. (Conrad), US Patent No. 6,307,545, and further in view of Takeda et al. (Takeda), US Patent No. 6,549,302.

17. As to claims 1 and 21, Conrad discloses a document handling apparatus for editing document file data, comprising:

 window display means for displaying a list window area for lining up a plurality of icons/thumbnails for document files and a palette window area for editing the document file, said palette window area being enable to import document file shown in said list window area and to show icons/thumbnails corresponding to the document file imported (col. 1, lines 32-57 and col. 4, lines 5-28); and

 However, Conrad does not explicitly disclose file operation means for executing a page division process or a page unification process of document file on the basis of an operation for the icon/thumbnails shown on said palette

Art Unit: 2176

window area. Takeda discloses a method that enables a user to divide (division process) one document into plural documents or combine (unification process) several documents into one (col. 14, line 18 – col. 15, line 53). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Takeda and Conrad to include file operation means for executing a page division process or a page unification process of document file on the basis of an operation for the icon/thumbnails shown on said palette window area. Takeda provides an image processing system which can read manuscripts/documents and carry out image processing on the basis of the management information corresponding to the images of the read documents.

18. As to claim 2, Conrad and Takeda (Conrad-Takeda) disclose the document handling further comprising a display device, wherein said window display means displays said list window area and said palette window area through said display device (Conrad, Figs 1 and 2A-2F).

19. As to claim 3, Conrad-Takeda disclose wherein each document file is corresponding to file data stored in a memory, and said file operating means operates each document file on the basis of the file data in the memory (Conrad, col. 3, line 57 – col. 4, line 25).

20. As to claims 4 and 22, Conrad-Takeda disclose wherein said file operating means exports the document file processed by the division process or the

Art Unit: 2176

unification process on the palette window area into the list window area (Conrad, col. 6, lines 10-31).

21. As to claims 5 and 23, Conrad-Takeda disclose wherein the document file is able to output by an operation for the icon/thumbnail shown in the palette window (Conrad, Abstract).

22. As to claims 6 and 24, Conrad-Takeda disclose wherein the document file on the palette window area is enable to receive an input operation (Conrad, col. 5, lines 19-44 and col. 7, lines 1-14).

23. As to claim 7, Conrad-Takeda disclose wherein said file operating means creates a duplicated file of the document file being imported to the palette window area in accordance with the page division process (Takeda discloses a method that enables a user to divide (division process) one document into plural documents or combine (unification process) several documents into one (col. 14, line 18 – col. 15, line 53. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Takeda and Conrad to include file operation means for executing a page division process or a page unification process of document file on the basis of an operation for the icon/thumbnails shown on said palette window area. Takeda provides an image processing system which can read manuscripts/documents and carry out image

Art Unit: 2176

processing on the basis of the management information corresponding to the images of the read documents).

24. Claims 18-20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda et al. (Takeda), US Patent No. 6,549,302 and further in view of Conrad et al. (Conrad), US Patent No. 6,307,545.

25. As to claim 18, Takeda discloses the limitations as discussed in claims 8-10 and 12-17 above. However, Takeda does not explicitly disclose window display means for displaying a list window area for lining up a plurality of icons/thumbnaill for document files and a palette window area for editing the document file. Conrad discloses a system providing the ability to move icons within one window to another window by executing a drag operation and those (col. 1, lines 32-57, col. 2, lines 1-63, and col. 4, lines 5-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Conrad and Takeda to include window display means for displaying a list window area for lining up a plurality of icons/thumbnaill for document files and a palette window area for editing the document file. Conrad provides such system with graphical user interfaces for finding moving and copying icons between graphical user interfaces.

26. As to claim 19, Takeda and Conrad disclose a display device, wherein said window display means displays said list window area and said palette

Art Unit: 2176

window are through said display device (Conrad, col. 1, lines 32-57, col. 2, lines 1-63, and col. 4, lines 5-28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Conrad and Takeda to include window display means for displaying a list window area for lining up a plurality of icons/thumbnail for document files and a palette window area for editing the document file. Conrad provides such system with graphical user interfaces for finding moving and copying icons between graphical user interfaces.)

27. As to claims 20 and 30, Takeda and Conrad disclose wherein said editing means executes the page division process and/or the page editing process through an operation for the icon/thumbnail shown on said palette window area (Conrad, col. 1, lines 32-57, col. 2, lines 1-63, and col. 4, lines 5-28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Conrad and Takeda to include window display means for displaying a list window area for lining up a plurality of icons/thumbnail for document files and a palette window area for editing the document file. Conrad provides such system with graphical user interfaces for finding moving and copying icons between graphical user interfaces.)

Art Unit: 2176

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (703) 305-4639. The Examiner's future phone number is (571) 272-4092, which will be effective sometime in October 2004. The Examiner can normally be reached on Monday-Friday from 8:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Joseph Feild, can be reached at (703) 305-9792.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen
Patent Examiner
Art Unit 2176



**SANJIV SHAH
PRIMARY EXAMINER**